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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/590,309

10/12/2006

Yuichi Ohkawara

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EXAMINER

BROWN, COURTNEY A

ART UNIT

PAPER NUMBER

1616

NOTIFICATION DATE

DELIVERY MODE

08/05/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/590,309	<b>Applicant(s)</b> OHKAWARA, YUICHI	
	<b>Examiner</b> COURTNEY BROWN	<b>Art Unit</b> 1616	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 27 April 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 8-10, 12 and 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/23/06</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restriction***

Applicant's election without traverse of Group IV, claims 1-7 and 11 and as the elected species, the compound of formula I wherein X=N and A+B in the compound of formula II is 1,3,5 oxadiazine in the reply filed on April 27, 2010 is acknowledged.

### ***Status of Claims***

Claims 1-13 are pending in the application. Claims 8-10, 12 and 13 have been withdrawn as being directed to a non-elected invention. Claims 1-7 and 11 are being examined for patentability.

### ***Priority***

Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e), 119(a-d), or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. This application is a 371 of PCT/JP05/02708 filed on February 21, 2005.

### ***Information Disclosure Statement***

The Information Disclosure Statements (IDS) submitted on August 23, 2006 has been considered by the examiner.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1,2,6, 7 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "kinds of compounds" in claim 1, analogous to the term "type", is a relative term which renders the claim indefinite. The term "kinds of compounds" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. As a result, the additional crop protection agent has been rendered indefinite by the use of the term "kinds of compounds". Claims 2,6,7 and 11 are rejected because they depend on rejected claim 1.

### ***Double Patenting***

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to

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identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

Claims 1-7 and 11 of this application conflict with claims 1-7 and 11 of Application No. 12/788679. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-6 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-6 of copending Application No. 12/788679. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 103***

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

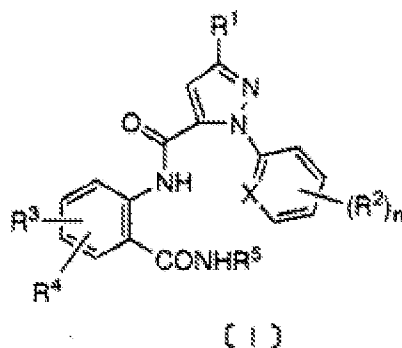
1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

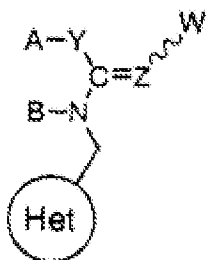
**Claims 1-7 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berger et al. (US Patent 7,696,232 B2).**

### ***Applicant's Invention***

Applicant claims an insecticide composition which comprises one or not less than two kinds of compounds being selected from a compound represented by the formula[I]:

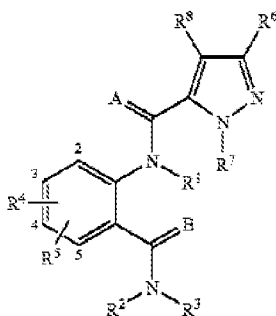


wherein R1, R2, R3 and R4 are the same or different, and each represent a hydrogen atom, a C1-6 alkyl group, a C1-6 haloalkyl group or a halogen atom; R5 is a hydrogen atom or a C1-6 alkyl group; X is CH or N; n is 0 to 3, or a salt thereof, and a neonicotinoid compound represented by the formula [II]:



***Determination of the scope and the content of the prior art  
(MPEP 2141.01)***

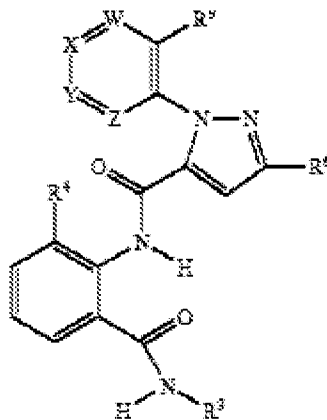
Berger et al. teach methods for protecting a propagule or a plant grown therefrom from invertebrate pests comprising contacting the propagule or the locus of the propagule with a biologically effective amount of a compound of Formula I (see below), its N-oxide or an agriculturally suitable salt thereof (abstract). Berger et al. teach that their invention relates to **the control of phytophagous invertebrate pests** such as arthropod pests by contacting plant propagules or the locus of the propagules with certain anthranilamides as well as propagule-coating compositions comprising said anthranilamides (column 1, lines 10-17). Berger et al. teach the compound of instant formula I (compound of formula I of Berger et al. shown below wherein :R<sub>8</sub>=H; R<sub>7</sub>= a hetroaromatic ring (X=N of instant application); R<sub>1</sub>,R<sub>4</sub>,R<sub>5</sub>, and R<sub>6</sub>= H, C<sub>1</sub>-C<sub>6</sub> alkyl group, a C<sub>1</sub>-C<sub>6</sub> haloalkyl group or a halogen atom; R<sub>2</sub> and R<sub>3</sub>=H or C<sub>1</sub>-C<sub>6</sub> alkyl; A=O and B=O (see claim 1 of Berger et al.).





Compound of formula I of Berger et al.

Berger et al. teach the use of the compound of instant formula I and at least one additional biologically active compound or agent such as **clothianidin** (compound of formula II of instant application wherein A+B= 1,3,5 oxadiazine), , **imidacloprid**, **thiacloprid**, **thiamethoxam**, **acetamiprid**.( neonicotinoid compound of instant application, see claims 5 and 7 of Berger et al.). Specifically, Berger et al. teach the compound below (see table 2 of column 59 of Berger et al.) wherein **W, X and Y=CH**; **Z=N**; **R3=an isopropyl group**; **R4=methyl** and **R6 and R9= chlorine** (compound IA of instant application as disclosed in instant claim 4).



For growing-medium drenches, Berger et al. teach that the formulation needs to provide the Formula I compound, generally after dilution with water, in solution or as particles small enough to remain dispersed in the liquid. Berger et al. teach that water-dispersible or soluble powders, granules, tablets, emulsifiable concentrates, aqueous suspension concentrates and the like are formulations suitable for **aqueous drenches of growing media**. Berger et al. teach that the drench liquid comprising the Formula I

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compound can be added to a liquid growing medium (i.e. hydroponics), which causes the Formula I compound to become part of the liquid growing medium (column 84, lines 53-66).

***Ascertainment of the difference between the prior art and the claims  
(MPEP 2141.02)***

The difference between the invention of the instant application and that of Berger et al. is that Berger et al. do not expressly teach an example of a composition comprising the compounds of instant formula I and II.

***Finding of prima facie obviousness***

***Rationale and Motivation (MPEP 2142-2143)***

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teaching of Berger et al. to arrive at a composition comprising the compounds of instant formulas I and II for the use of controlling an insect pest. Berger et al. suggest the use of the compounds of instant formulas I and II for the control of phytophagous invertebrate pests such as arthropod pests. One would have been motivated to use the teaching of Berger et al. because all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at

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the time of the invention. Thus, in view of *In re Kerkhoven*, 205 USPQ 1069 (C.C.P.A. 1980), it is *prima facie* obvious to combine two or more compositions each of which is taught by prior art to be useful for the same purpose in order to form a third composition that is to be used for the very same purpose. The idea of combining them flows logically from their having been individually taught in prior art.

In light of the forgoing discussion, the Examiner concludes that the subject matter defined by the instant claims would have been obvious within the meaning of 35 USC 103(a).

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

**Conclusion**

None of the claims are allowed.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Courtney A. Brown whose telephone number is 571-270-3284. The examiner can normally be reached on 9:00 am-5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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